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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/726,899 11/29/00 BANDMAN

0 PF-0187-2 DI

HM12/0201

LEGAL DEPARTMENT  
INCYTE GENOMICS, INC.  
3160 PORTER DRIVE  
PALO ALTO CA 94304

EXAMINER

ROARK, J

ART UNIT	PAPER NUMBER
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1644

DATE MAILED:

02/01/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/726,899

Applicant(s)

BANDMAN ET AL.

Examiner

Jessica H. Roark

Art Unit

1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-13 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_.

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## DETAILED ACTION

### *Sequence Compliance*

1. The instant application is in sequence compliance for patent applications containing nucleotide sequence and/or amino acid sequence disclosures.

### *Restriction Requirement*

2. Please Note: In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-308-4315. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Paula Hutzell, Ph.D., Supervisory Patent Examiner at Paula.Hutzell@uspto.gov or 703-308-4310. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

3. The following is noted:

The specification discloses that SEQ ID NOS 1, 3, 5 and 7 each differ with respect to their structures and physiochemical properties (e.g., "Brief Description of the Figures" and Figures 5-8 of the specification as-filed). Although each polypeptide is proposed to be a subunit of NADH dehydrogenase, the specification indicates that individual subunits have different functions (e.g. at page 2, lines 4-9), and widely vary in their size and composition (e.g., page 1, lines 24-25). A person of ordinary skill in the art thus would not envision one polypeptide in view of the other. Consequently, because the polypeptide of each SEQ ID NO is structurally distinct; antibodies recognizing one subunit polypeptide would not be envisioned by a person of ordinary skill in the art in view of an antibody to the other polypeptide subunits.

*Therefore, the restriction has been set forth for each as separate groups, irrespective of the format of the claims.*

4. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-11, drawn to antibodies to the polypeptide of SEQ ID NO:1, methods of preparing, and pharmaceutical compositions thereof; classified in Class 530, subclass 387.1; Class 424, subclass 130.1.

II. Claims 1-11, drawn to antibodies to the polypeptide of SEQ ID NO:3, methods of preparing, and pharmaceutical compositions thereof; classified in Class 530, subclass 387.1; Class 424, subclass 130.1.

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III. Claims 1-11, drawn to antibodies to the polypeptide of SEQ ID NO:5, methods of preparing, and pharmaceutical compositions thereof; classified in Class 530, subclass 387.1; Class 424, subclass 130.1.

IV. Claims 1-11, drawn to antibodies to the polypeptide of SEQ ID NO:7, methods of preparing, and pharmaceutical compositions thereof; classified in Class 530, subclass 387.1; Class 424, subclass 130.1.

V. Claim 12, drawn to a method of detecting the polypeptide of SEQ ID NO:1 with an antibody, classified in Class 435, subclass 7.1.

VI. Claim 12, drawn to a method of detecting the polypeptide of SEQ ID NO:3 with an antibody, classified in Class 435, subclass 7.1.

VII. Claim 12, drawn to a method of detecting the polypeptide of SEQ ID NO:5 with an antibody, classified in Class 435, subclass 7.1.

VIII. Claim 12, drawn to a method of detecting the polypeptide of SEQ ID NO:7 with an antibody, classified in Class 435, subclass 7.1.

IX. Claim 13, drawn to a method of purifying the polypeptide of SEQ ID NO:1 with an antibody, classified in Class 530, subclass 413.

X. Claim 13, drawn to a method of purifying the polypeptide of SEQ ID NO:3 with an antibody, classified in Class 530, subclass 413.

XI. Claim 13, drawn to a method of purifying the polypeptide of SEQ ID NO:5 with an antibody, classified in Class 530, subclass 413.

XII. Claim 13, drawn to a method of purifying the polypeptide of SEQ ID NO:7 with an antibody, classified in Class 530, subclass 413.

5. Groups I, II, III, and IV are different products. As discussed supra, antibodies to the different polypeptides of SEQ ID NOS:1, 3, 5, and 7 differ with respect to their structures and physicochemical properties; therefore antibodies to each product is patentably distinct.

6. Groups V-XII are different methods. Methods of detecting and methods of purifying different polypeptides using different antibodies to the polypeptides each differ with respect to ingredients, method steps, and endpoints; therefore, each method is patentably distinct.

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7. Groups (I and V/IX), (II and VI/X), (III and VII/XI), and (IV and VIII/XII) are related as product and process of using. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the antibodies of Groups I/II/III/IV can each be used for either affinity purification or detecting the protein, as recited. In addition, the antibodies can be used as immunogens to make anti-idiotypic antibodies.

8. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter, restriction for examination purposes as indicated is proper.

9. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

10. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica Roark whose telephone number is (703) 605-1209. The examiner can normally be reached Monday through Friday from 8:00 AM to 4:30 PM. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-3014.

Jessica Roark, Ph.D.  
Patent Examiner  
Technology Center 1600  
January 29, 2001

PHILLIP GAMBEL  
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PRIMARY EXAMINER  
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1/30/01